

**REMARKS**

Claims 1-50 are currently pending in the application. Claims 30-38 and 50 are allowed. Claims 1-6, 9-11, 13-15, 16, 18, 19, 21, 23, 26, 39, 42, 44 and 48 have been rejected. Claims 7, 8, 12, 17, 20, 22, 24, 25, 27-29, 40, 41, 43, 45-47 and 49 are objected to as being dependent upon a rejected base claim.

Applicants thank the Examiner for favorable consideration and allowance of claims 30-38 and 50.

On page 2 of the Office Action, claims 1-6, 9-11, 13, 15-16, 18-19, 21, 23, 26, and 39 are rejected under 35 U.S.C. §102 (b) as being anticipated by Duran (U.S. Patent No. 5,545,215). Applicants respectfully traverse the rejections.

On page 3 of the Office Action, claims 42 and 44 are rejected under 35 U.S.C. §102 (b) as being anticipated by Klostermeyer, et al. (U.S. Patent No. 5,891,195). Applicants respectfully traverse the rejections.

On page 3 of the Office Action, claim 48 is rejected under 35 U.S.C. §102 (b) as being anticipated by Fogarty, et al. (U.S. Patent No. 5,824,037). Applicants respectfully traverse the rejection.

To anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all

claim elements, and their limitations, must be found in the prior art reference to maintain a rejection based on 35 U.S.C. §102.

Applicants respectfully submit that Duran does not teach every element of claims 1 and 39, and therefore fails to anticipate claims 1 and 39.

First, contrary to the Examiner's assertions, Applicants' expanded section is not disclosed by Duran's conduit. The bulges 48 of Duran's conduit 28 corresponding to the sinuses of Valsalva are expandable. (See *Duran*, Figs 8-9). This is clearly different from Applicants' expanded section. (See Fig. 1).

Further, the expanded section extends from an end of the generally cylindrical section. "Section" is singular, indicating the presence of a single generally cylindrical section in the invention. Duran's open cage frame 20 is disposed between two cylindrical conduit sections. (See Fig. 9).

In Duran, due to the shape of the stent and the positioning of the bulges 48, there appear to be six junctions between the top and the bottom of the bulges 48 and the two cylindrical sections of the conduit 28. In contrast, Applicants claim a reinforcement element that is circumferentially positioned at the one junction between the generally cylindrical section and the expanded section. Thus, Duran does not disclose the circumferential positioning of the reinforcement element as claimed by Applicants.

Since Duran does not disclose every element of the claimed invention for at least the above reasons, Duran fails to anticipate claim 1. Applicants respectfully request withdrawal of the rejection of claim 1 as being anticipated by Duran.

Dependent claims 2-6, 9-11, 13, 15, 16, 18, 19, 21, 23 and 26 which depend from independent claim 1 were also rejected under 35 U.S.C. §102(b) as being anticipated by

Duran. While Applicants do not acquiesce with the particular rejection to these dependent claims, it is believed that these rejections are moot in view of the remarks made in connection with independent claim 1. These dependent claims include all of the limitations of the base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. Therefore, dependent claims 2-6, 9-11, 13, 15, 16, 18, 19, 21, 23 and 26 are also in condition for allowance.

Applicants respectfully request withdrawal of the rejection of claims 2-6, 9-11, 13, 15, 16, 18, 19, 21, 23 and 26 as being anticipated by Duran.

With respect to the rejection of claim 39, the Examiner states that a portion of the reinforcement element 20 is attached downstream from the valve. As discussed in connection with claim 1 above, Duran's "reinforcement element" is actually an open cage frame 20 that is disposed in the central portion of the conduit 28 so that the frame does not extend towards one end of the conduit. Claim 39 sets forth a prosthesis that includes a reinforcement element and a prosthetic conduit wherein the reinforcement element is circumferentially attached towards one end of the prosthetic conduit and downstream of the valve. Thus, Duran does not disclose all elements of claim 39, and therefore Duran fails to anticipate claim 39.

Applicants respectfully request withdrawal of the rejection of claim 39 as being anticipated by Duran.

The Examiner states that claim 42 is clearly anticipated by Figure 3 of Klostermeyer. Applicants respectfully submit that Klostermeyer does not teach every element of claim 42, and therefore fails to anticipate claim 42.

Klostermeyer discloses a prosthetic device that has a valve 14 combined with a graft 12. The proximal end 60 of the graft 12 is in communication with the valve 14. The proximal end 60 of the graft 12 is narrower than the wider tubular portion 18 of the graft due to taper 62 connecting the narrower portion with the wider tubular portion 18. The walls of the wider tubular portion 18 are corrugated 59. (Figures 2 and 3, col. 4, lines 36-38.) Thus, the basic shape of the graft 12 disclosed by Klostermeyer is a cone shaped tubular structure with corrugated edges.

Claim 42 of the present invention states that a prosthesis comprises a first prosthetic conduit section with a generally cylindrical section and a second integral prosthetic conduit section comprising a prosthetic valve. The inflow edge of the first conduit section is configured for attachment to the outflow edge of the second conduit section. Thus, claim 42 sets forth that the first conduit section is cylindrical.

The general longitudinal sectional shape of Klostermeyer's graft section is one of a corrugated cone shaped tube, not cylindrical as claimed by Applicants. Klostermeyer does not disclose the first conduit section having a generally cylindrical section and, as a result, does not anticipate claim 42.

Applicants respectfully request withdrawal of the rejection of claim 42 as being anticipated by Klostermeyer.

Dependent claim 44, which depends from independent claim 42, was also rejected under 35 U.S.C. §102(b) as being anticipated by Klostermeyer. While Applicants do not acquiesce with the particular rejection to this dependent claim, it is believed that this rejection is moot in view of the remarks made in connection with independent claim 42. This dependent claim includes all of the limitations of the base

claims and any intervening claims, and recites additional features which further distinguishes this claim from the cited references. Therefore, dependent claim 44 is also in condition for allowance.

Applicants respectfully request withdrawal of the rejection of claim 44 as being anticipated by Klostermeyer.

Regarding claim 48, Applicants respectfully submit that Fogarty does not teach every element of claim 48, and therefore fails to anticipate claim 48.

The Examiner states that Figure 3 of Fogarty anticipates claim 48.

Fogarty discloses an intraluminal prosthesis that is assembled from prosthetic modules. Each module has an interface and an element for engaging and/or sealing two modules together at the interfaces. (See Fig. 3). For example, Figs 3B and 3C illustrate the use of barbs to seal modules together. Figure 3D illustrates the use of a helical winding for threaded attachment of adjacent modules.

In contrast to Fogarty's engaging and sealing element, claim 48 comprises a reinforcement element that is circumferentially attached to the prosthetic conduit proximate to the outflow edge. Moreover, Fogarty's engaging and sealing element is disposed at the junction of two prosthetic modules, not proximate to the conduit's outflow edge as claimed by Applicants. Thus, Fogarty does not anticipate claim 48.

Applicants respectfully request withdrawal of the rejection of claim 48 as being anticipated by Fogarty.

On page 3 of the Office Action, claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duran in view of Laperie et al (US 6,068,657). Applicants respectfully traverse this rejection.

Three criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference, or combination of references, must teach or suggest all the claim limitations. MPEP § 2142. Applicants respectfully traverse the rejection since the prior art fails to disclose all the claim limitations.

Claim 14 depends from claim 13 which, in turn, depends from independent claim 1. As discussed at length above in connection with claim 1, Duran fails to meet all limitations of claim 1, including that Duran relates to an expandable conduit section, not an expanded conduit section, Duran's open cage frame 20 is disposed between two cylindrical conduit sections, and there appears to be six junctions between the top and the bottom of the bulges 48 and the two cylindrical sections of the conduit 28. Lapeyre simply discloses a prosthetic heart valve. Lapeyre fails to remedy any of the deficiencies of Duran.

For at least these reasons, Applicants submit that the proposed combination of references fails to disclose every limitation in claim 1 and claim 13. Claim 14 depends from claim 13. It is believed that the rejection of claim 14 is moot in view of the remarks made in connection with independent claim 1 and dependent claim 13.

Applicants respectfully request withdrawal of the rejection of claim 48 under 35 U.S.C. §103(a) as obvious over Duran in view of Lapeyre.

In view of the amendments and reasons provided above, it is believed that all pending claims are in condition for allowance. Applicants respectfully request favorable reconsideration and early allowance of all pending claims.


If a telephone conference would be helpful in resolving any issues concerning this communication, please contact Applicants' attorney of record, Hallie A. Finucane at (952) 253-4134.

Respectfully submitted,

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